

U.S. Application No. 09/942,672
Client/Matter: 016795-0282906

REMARKS

I. Status of the claims

Claims 1, 2, and 4-25 are pending. Claim 3 has been cancelled. Claims 1, 18, and 20-23 have been amended to recite the formulation or composition as oil-based. Support for this amendment may be found in paragraph 9 and throughout the specification. Claims 20 and 22 have also been amended to recite methods wherein the methods recite composition containing at least one polymer. Claim 18 has been amended to correct a dependency. No new matter has been added through these amendments.

II. Rejection over Mann

The examiner has rejected claim 20 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,030,948 to Mann ("Mann"). Applicants respectfully traverse this rejection.

Mann is directed to hair regeneration compositions for treating alopecia on the scalp which includes the optional step of applying a topical anesthetic to the scalp prior to applying the hair regeneration composition. See abstract.

Mann describes the topical anesthetic in col. 12, line 35 to col. 13, line 18. As set forth in Table 9, the major components of the topical anesthetic composition are alcohols (benzyl alcohol, phenoxyethanol) and esters (isopropyl palmitate, isopropyl myristate).

Applicants have amended claim 20 to recite a method of desensitizing the scalp that comprises applying an oil-based composition to the scalp. In contrast, Mann uses a composition in which alcohols and esters are the main components. Because Mann does not teach an oil-based composition, Mann does not anticipate claim 20. Accordingly, Applicants respectfully request that this rejection be withdrawn.

III. Rejection over Nakayama

The examiner has rejected claim 20 and 22-25 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 4,054,954 to Nakayama et al. ("Nakayama"). Applicants respectfully disagree.

Nakayama relates to a method for providing hair at the human scalp through an improved surgical method. See col. 1, lines 5-8 and abstract. Nakayama teaches that the scalp may be anesthetized by injecting an appropriate amount of local anesthetic, such as

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Novocaine, in the scalp together with an appropriate blood coagulant. See col. 3, lines 64-67 and claim 7. Nakayama thus injects pure local anesthetic in its neat form.

Nakayama does not teach the step of applying a composition containing an anesthetic, as recited in Applicants' claims 20 and 22-25. Instead, Nakayama only teaches that the anesthetic may be injected into the scalp. Additionally, because Nakayama injects pure local anesthetic into the scalp in its neat form, Nakayama does not teach a composition that contains an anesthetic and at least one polymer.

Therefore, Nakayama fails to teach Applicants' claimed invention, and Applicants respectfully request that this rejection be withdrawn.

IV. Rejection over Kaplan and Smith

The examiner has rejected claims 1-19 and 21 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 4,052,513 to Kaplan ("Kaplan") in view of U.S. Patent No. 5,874,074 to Smith ("Smith"). Applicants respectfully traverse this rejection.

Kaplan relates to a cosmetically elegant and stable oil-in-water emulsion for use as a topical anesthetic. See abstract. The examiner states that Kaplan does not teach copolymers and plant oils, but relies on Smith for those teachings. Smith relates to an occlusive or semi-occlusive barrier moisturizing lotion composed of an oil-in-water emulsion. See abstract.

Thus, Kaplan and Smith both teach composition that they each independently classify as oil-in-water emulsions. As known to those of skill in the art, oil-in-water emulsions consist of a continuous phase (water) and a disperse phase (oil), and typically have the consistency of milk or a lotion.

In contrast to the teachings of Kaplan and Smith, Applicants have amended claims 1 and 21 to recite oil-based formulations. Oil-based formulations are different from an oil-in-water emulsion in that no emulsion is formed and water is not used as a continuous phase.

Because Kaplan and Smith fail to teach or suggest oil-based formulations, the references, alone or in combination, fail to render obvious Applicants claimed invention. Accordingly, Applicants respectfully request that the examiner withdrawn this rejection.

V. Conclusion


If any issues in this application remain unresolved, the examiner is encouraged to contact the undersigned counsel at the number listed below in order to resolve such issues.

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Please charge any fees associated with the submission of this paper to Deposit Account No. 033975. The Director is also authorized to credit any overpayments to the above-referenced Deposit Account.

Respectfully submitted,

PILLSBURY WINTHROP SHAW PITTMAN LLP

By: 
Jeffrey N. Townes
Registration No. 47,142

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1650 Tysons Boulevard
McLean, VA 22102
703.770.7900 Telephone
703.770.7901 Facsimile